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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,652	11/10/2003	Peter Callas	80121-08601	6132
758	7590	05/05/2005		
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER MENDOZA, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/705,652	Applicant(s) CALLAS ET AL.	
	Examiner Michael G. Mendoza	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 12 and 13 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9, 11 and 14 is/are rejected.
- 7) ☒ Claim(s) 8, 10 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3, 5-7, 11, and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6811546 in view of Fogarty et al. 5979452. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims merely adds a feature absent from the patent claim. The structural limitations set forth in the application claims are also claimed the patent claims, i.e., a body including a central bore, a balloon near a distal end, a resilient sealing member, an insufflation inlet, and an auxiliary sealing member.

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4. The difference between Claims 1 and 5 of the instant application and the patent claims is the inflatable balloon expanding radially outwardly about the body unobstructively of the central bore.

5. Forgarty et al. teaches a balloon expanding radially outwardly about the body unobstructively of a central bore.

6. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach balloon of Forgarty et al. to the attachment site of the patent to allow dissection of a surgical site and provide a access to an endoscopic instrument.

7. As to Claims 2 and 3 of the instant application, the patent claims fails to teach the toroidally-shaped balloon.

8. However, the use of toroidally-shaped balloons is old and well known in the art of internal pressure applicators (evidenced by US Patents 3848602, 4364392, 4723549). Therefore, it would have been obvious to use a toroidally-shaped balloon as an obvious design choice for forming a seal within the body of a patient.

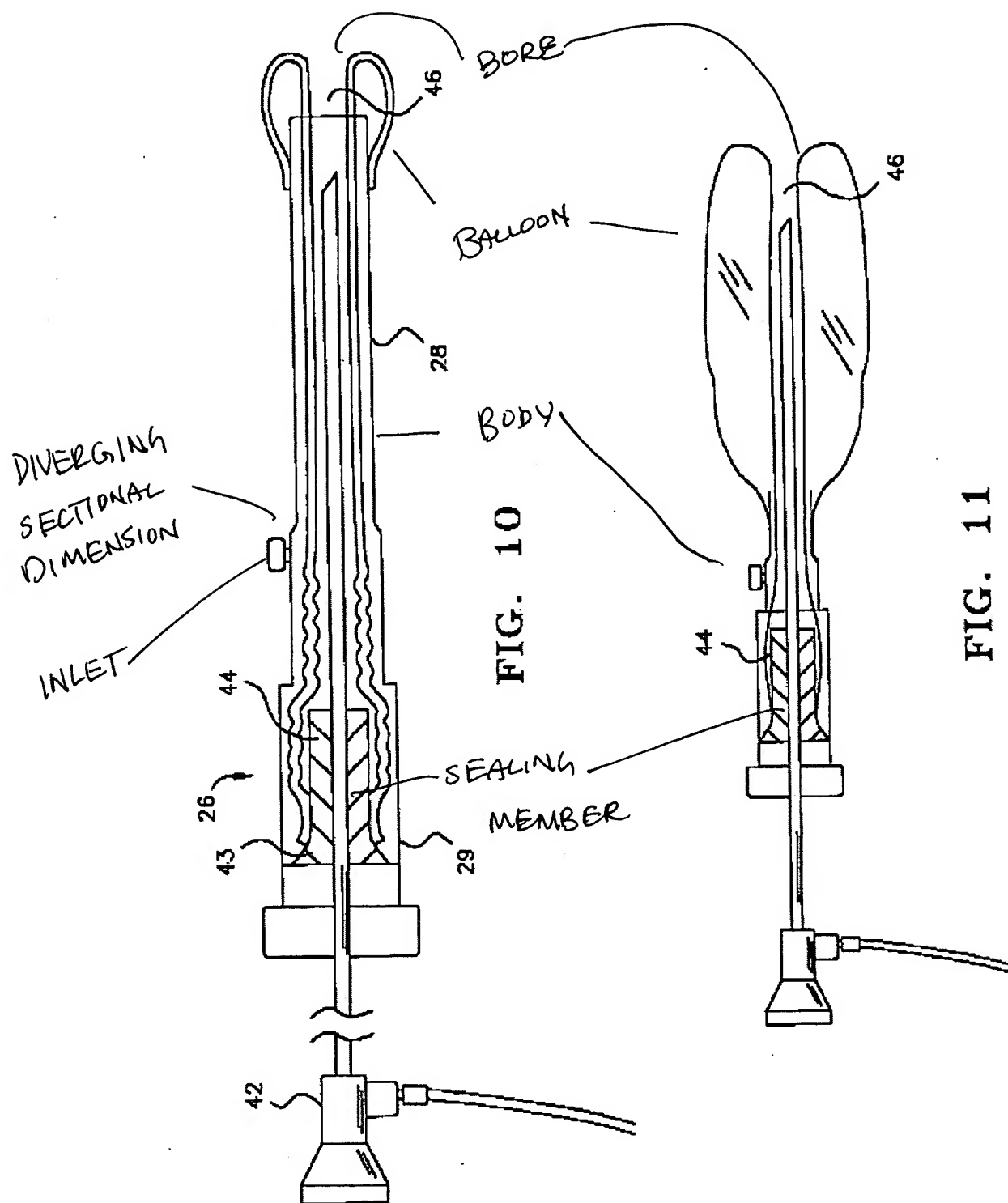
9. As to Claim 5 of the instant application, the patent claim teaches a sealing member for attachment to a body having a central bore. It would have been obvious to provide the body having the central bore for the sealing member to attach to.

Claim Rejections - 35 USC § 103

10. Claims 1-3, 7, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fogarty et al. 5979452 in view of Chin 5873889

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11. Fogarty et al. teaches fluid sealing apparatus for operation with an endoscopic instrument at a surgical site, the apparatus comprising: a body having a central bore; an inflatable element expanding radially outwardly about the body unobstructively of the central bore; and a resilient fluid seal. It should be noted that Fogarty et al. fails to teach wherein the resilient fluid seal is disposed external to the body.

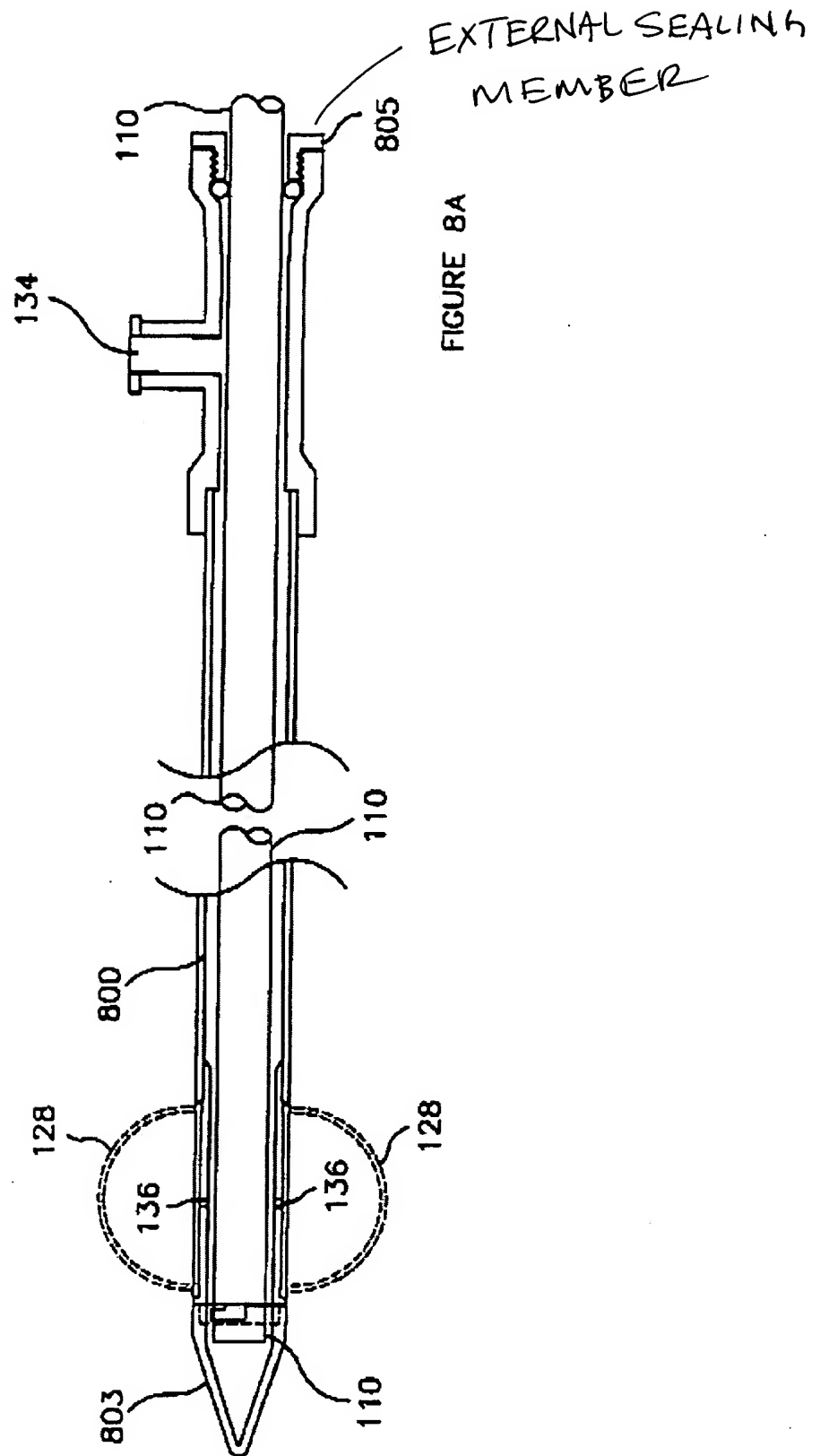


12. Chin teaches a device with a common external resilient fluid seal 805. Therefore, it would have been obvious to one having ordinary skill in the art at

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the time the invention was made to place the seal externally for easy replacement if damaged or for easy cleaning.

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Allowable Subject Matter

13. Claims 4, 12, and 13 are allowable over the prior art of record.

14. Claims 8, 10, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or render obvious the overall claimed endoscopic surgical procedure performed through an access port, the procedure comprising: forming a fluid-tight seal in an access port in response to insertion of a endoscopic instrument in the access port; insufflating the anatomical space with fluid under pressure during formation of the fluid-tight seal; and disabling a fluid-tight seal within the access port to permit deflating the anatomical space inflated with fluid under pressure upon removal of an endoscopic instrument from within the access port.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-44963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MM



GLENN K. DAWSON
PRIMARY EXAMINER